

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

VAN DEN BERG

Appln. No. 10/575,369

Filed: April 11, 2006

Confirmation No. 9073

Atty. Ref.: 4662-168

T.C. / Art Unit: 1652

Examiner: H.A. Robinson

FOR: METHOD FOR PREPARING A MODIFIED HOST CELL

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**PETITION UNDER 37 CFR §§ 1.144 AND 1.181**

November 9, 2009

**Mail Stop Amendment**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant petitions the Director to invoke his supervisory authority and to review the Examiner's final restriction requirement. In accordance with M.P.E.P. § 1002.02(c), it is understood that authority to decide this petition may be delegated to a Technology Center Director.

The Director is respectfully requested to order the Examiner to search and examine independent claims 1 and 15 (as well as claims depending therefrom) in this patent application.

The Rule 17(h) fee of \$130 for this petition is attached. If the fee is missing or deficient, authority is given to charge any deficiency in the fee which should have been filed herewith to our Deposit Account No. 14-1140 under Order No. 4662-168.

**ISSUE IS RIPE FOR REVIEW**

A restriction requirement was made in the Office Action mailed June 4, 2008: the 26 claims were restricted into five groups by the Examiner. Applicant traversed the requirement in his response filed August 4, 2008. Group I (i.e., claims 1-9) drawn to a method for preparation of a modified host cell was elected.

The restriction requirement was made final in the Office Action mailed November 26, 2008. Claims 10-26 were withdrawn from consideration by the Examiner.

This petition is timely because the restriction requirement was made final and an appeal has not yet been filed in this patent application.

**STATEMENT OF FACTS AND POINT(S) TO BE REVIEWED**

Claims 1-21, 23-25 and 27-38 are pending. Claims 10-21, 23-25 and 27-28 are presently withdrawn from consideration by the Examiner. Applicant requests that the Examiner be ordered to examine claims 15 and 27-28 because they are directed to the elected invention of claims 1-9. The other non-elected claims are being maintained in this patent application to permit rejoinder of claims 10-14, 16-21 and 23-25.

Claims 1-9 have been examined by the Examiner. They are drawn to the elected invention (i.e., a method for preparation of a modified host cell). In the response filed March 26, 2009, Applicant amended claim 15 and 27-28 to be directed to a method for preparation of a modified host cell. On page 2 of Applicant's response, claims 27-28 were described as drawn to the elected invention. On page 7 of Applicant's response, claim 15 was described as being amended to be drawn to the elected invention. The amendment of claim 15 was supported by a combination of original claims 1-2, 4 and 6-7 as well as the specification (e.g., page 4, lines 2-6). Thus, Applicant complied with the requirement of bringing the status of claims 15 and 27-28 to the Examiner's attention by stating that the amended and new claims are directed to the same invention as elected claims 1-9.

In the Office Action mailed June 8, 2009, the Examiner withdrew claims 15 and 27-28 from consideration as allegedly "being drawn to a non-elected invention" without any acknowledgment that the amendment of claim 15 had changed its status from non-elected Group III to elected Group I.

Applicant disagrees with the Examiner's assertion that claims 15 and 27-28 are drawn to a non-elected invention. Comparison of independent claim 1, which has been examined, to independent claim 15 shows there is unity of invention because they are both directed to a method for preparation of a modified host cell. Further, the scope of claim 15 is wholly encompassed in the scope of claim 1. Thus, examination of claims 15 and 27-28 would not be a serious burden in view of the already examined claims 1-9.

**ACTION REQUESTED**

Applicant submits that claims 1-9, 15 and 27-38 are drawn to the same invention, which was elected for examination. Claims 1-9 have been examined. It is requested that the Director find pending claims 15 and 27-28 drawn to the elected invention of Group I.

Claims 29-38 were added in the response submitted herewith. Thus, claims 29-38 are not the subject of this petition because the Examiner has not yet withdrawn them from consideration. But another petition will be filed if claims 29-38 are not examined in this patent application.

The Director is requested to invoke his supervisory authority over the Examiner's actions and to order her to examine claims 15 and 27-28 because they no longer belong to non-elected Group III after the amendment filed March 26, 2009. All claims directed to a method for preparation of a modified host cell should be searched and examined. Therefore, the Examiner should search and examine claims 1-9, 15 and 27-38 in the same patent application.

Applicant earnestly solicits grant of this petition. If any further information would assist in this decision, the Director or his designee is invited to contact the undersigned.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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